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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/847,711	04/28/97	CHAU	ME1718WWD

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MM11/0114

EXAMINER
DANG, H

ART UNIT	PAPER NUMBER
2873	9

DATE MAILED: 01/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/847,711

Applicant(s)

David Yinkai Chao

Examiner

Hung Dang

Group Art Unit

2873

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 7/31/98 and 12/15/98.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 2-7 and 9-13 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 2-7 and 9-13 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. The Terminal Disclaimer filed on 7/31/98 has been entered.
2. The amendment filed on 12/15/98 had been entered.

Information Disclosure Statement

3. The Information disclosure Statement filed on 7/31/98 has been considered.

Claims Rejection Under 35 USC - 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention described by the applicant for patent, or on an international application for patent by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 7 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by **Chao** (5,737,054).

Chao '054 disclose that a primary frame (10) including a first bridge (13), the first bridge (13) including a first magnetic (14), an auxiliary lens frame (20) having a second bridge (21) having an arm (22) extended rearward toward the primary frame (10) and extend over the first bridge (13), the a...

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including a rear end having a flange (24) extended downward for engaging with the first bridge and for securing the auxiliary frame to the primary frame, the flange (24) including a second magnet for engaging with the first magnet (14) and for securing the auxiliary frame to the primary frame. (See figures 1, 2 and 4 and the related disclosure)

Claims Rejection Under 35 USC - 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-6 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chao** (5,737,054) in view of **Chao** (5,568,207).

Chao '054 disclose that a primary frame (10) including a first bridge (13), the first bridge (13) including a first magnetic (14), ~~an auxiliary lens frame (20) having a second~~ bridge (21) having an arm (22) extended rearward toward the primary frame (10) and extend over the first bridge (13), the arm

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including a rear end having a flange (24) extended downward for engaging with the first bridge and for securing the auxiliary frame to the primary frame, the flange (24) including a second magnet for engaging with the first magnet (14) and for securing the auxiliary frame to the primary frame. (See figures 1, 2 and 4 and the related disclosure) Chao '054 does not disclose that two side of the auxiliary frame each having an extension extended rearward toward the primary frame and extended over one of the studs, the extensions each including a rear end having a first flange extended downward.

Chao '207, however, discloses that two side of the auxiliary frame (20) each having an extension (21) extended rearward toward the primary frame (10) and extended over one of the studs (11), the extensions (21) each including a rear end having a first flange (22) extended downward (please see figure 15).

Because Chao '054 and Chao '207 are both from the same field of endeavor, the purpose of preventing the auxiliary spectacle frame from moving downward relative to the primary frame as disclosed by Chao '207 would have been recognized as art pertinent art of Chao '054.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to

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construct the auxiliary lenses for eyeglasses, such as the one disclosed by Chao '054, with two side of the auxiliary frame each having an extension extended rearward toward the primary frame and extended over one of the studs, the extensions each including a rear end having a first flange extended downward, such as disclosed by Chao '207 for the purpose of preventing the auxiliary spectacle frame from moving downward relative to the primary frame.

Claims Rejection Under 35 USC - 103

6. Claims 2-6 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chao** (5,568,207) in view of **Chao** (5,737,054).

Chao '207 discloses auxiliary lenses for eyeglasses which comprising a primary lens frame (10), an auxiliary lens frame (20). The auxiliary lens frame (20) having two magnetic members (22) secure to the arms (21) thereof for engaging with the magnetic members (14) of the primary lens frame (10) for securing the auxiliary lens frame (20) to the primary lens frame (10).

Chao '207 does not disclose that the bridge of the auxiliary lens frame having an arm extended over the bridge of the primary lens

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frame for securing the auxiliary lens frame to the primary lens frame.

Chao '054 disclose that the auxiliary lens frame having a middle bridge portion having a projection for engaging over the middle bridge portion of the primary lens frame and having a magnetic connector member for engaging with the connector member of the primary lens frame.

Because Chao '207 and Chao '054 are both from the same field of endeavor, the purpose of providing auxiliary lens frame which may be easily engaged on the primary lens frame as disclosed by Chao '054 would have been recognized as an art pertinent art of Chao '207.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the auxiliary lenses for eyeglasses, such as the one disclosed by Chao '207, with auxiliary lens frame having a middle bridge portion having a projection for engaging over the middle bridge portion of the primary lens frame and having a magnetic connector member for engaging with the connector member of the primary lens frame, such as disclosed by Chao '054 for the purpose of auxiliary lens frame which may be easily engaged to the primary lens frame.

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8. Applicant's arguments filed 12/15/98 have been fully considered but they are not persuasive.

It is argued at page 6 of the remarks that:

"Nothing in the '207 patent teaches or suggests modifying its frames to include one or more of Applicant's flanges"

This argument is not persuasive, since figure 7 of '207 patent clearly shown that the flange (22) is a magnetic member for engaging with the magnetic member (14) of the primary spectacle frame. Therefore the claimed invention does not distinguish over the '207 patent.

It is argued at page 7 of the remarks that:

"... the amended claim 7 not being found in the '504 patent, such as the claimed flanges, this rejection has been traverse."

This argument is not persuasive, since figure 4 of '504 patent clearly shown that the flange (24) is a magnetic member for engaging with the magnetic member (14) of the primary spectacle frame. Therefore the claimed invention does not distinguish over the '504 patent.

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9. Applicant's arguments with respect to claims 2-7 and 9-12 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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11. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (703) 308-0550.

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HUNG DANG

PRIMARY EXAMINER

TECHNICAL CENTER 2800
